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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,144	12/02/2003	David K. Swanson	015916-303	5308

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EXAMINER	
ROANE, AARON F	

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/727,144	SWANSON ET AL.	
	Examiner	Art Unit	
	Aaron Roane	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) *9,12,19,21,23-37,44 and 46* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10,11,13-18,20,22,38-43 and 45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/3/06,6/17/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: IDS:3/28/06,11/30/05,11/18/05,9/28/05,8/25/05,6/16/05.

DETAILED ACTION

Election/Restrictions

Claims 24-37 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/13/2006.

Claims 9, 12, 19, 21, 23, 44 and 46 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected specie, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/13/2006.

Applicant traverses the species distinct characterization between figures 16 and 17-23 and states in the response filed 7/13/2006, that figures 16 and 17-23 depict the same specie. The examiner agrees and hereby views figures 16 and 17-23 as illustrating the same specie.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 8, 13-16, 18, 22, 38-41, 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phan (USPN 6,692,491) in view of Tetzlaff et al. (USPN 6,277,117 B1) and in further view of Whayne et al. (USPN 6,115,626).

Regarding claims 1, 4-6, 8, 13-16, 18, 22, 38-41, 43 and 45, Phan discloses a method and forceps device for cardiac ablation/coagulation procedures, the device comprising first and second clamp members (190 and 192 respectively), first and second support members (194 and 196 respectively) secured to the first and second clamp members, and first and second ablation/coagulation electrode members (20 on 194 and 20 on 196) carried by the support device, see col. 16, line 46 through col. 18, line 10 and figures 21-25 in general and figure 25 in particular. The source of ablation/coagulation energy that is connected/coupled to the coagulation electrodes is inherent. Phan fails to explicitly recite that the support members are removably secured to the clamp members and that the support members carry stimulation elements. Tetzlaff et al. disclose vessel sealing forceps that utilize both mechanical clamping action and electrical energy to affect hemostasis, see col. 1, lines 13-65. Tetzlaff et al. teach providing a clamping forceps device with probes/electrodes (115 and 125) that are attached to the removable base members (111 and 121) in order to provide the clamping forceps device with electrical energy delivery to effect hemostasis of vessels and in order to provide a removable and disposable electrode assembly, see col. 1-7, and particularly col. 1, lines 10-65, and col.

3-6 and figures 1-11. Whayne et al. disclose a method and system for mapping and ablating cardiac tissue and teach "the techniques used to analyze these pathways, commonly called "mapping," identify regions in the heart tissue, called foci, which can be ablated to treat the arrhythmia. When used for this purpose, the multiple electrode arrays are typically located in electrical contact with either epicardial or endocardial tissue. The multiple electrodes are coupled to an external cardiac stimulator, which applies electrical pacing signals through one or more electrodes at given frequencies, durations, or amplitudes to myocardial tissue, a process called "pacing." The multiple electrodes on the array are also typically coupled to signal processing equipment, called "recorders," which display the morphologies of the electrocardiograms or electrograms recorded during pacing. Sometimes, another roving electrode is deployed in association with the multiple electrode array, to pace the heart at various endocardial locations, a technique called 'pace mapping.' When it is desired to ablate myocardial tissue, an electrode coupled to a source of, e.g., radio frequency energy is deployed," see col. 1, lines 19-38. Whayne et al. provides mapping electrodes that have the dual capability of stimulation/pacing in order to provide mapping capability of the targeted tissue. The stimulator (20) of Whayne et al. serves as the source of stimulation energy, see figure 2. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Bowe et al., as taught by Tetzlaff et al., to provide a removably securable electrode assembly and support such that the electrode assembly and support is removably securable to the clamp members in order to provide a removable and disposable electrode assembly, and as further taught by Whayne et al., to

provide mapping electrodes that have the dual capability of stimulation/pacing in addition to the ablation/coagulation electrodes in order to provide mapping capability of the targeted tissue.

Regarding claims 2 and 3, Phan in view of Tetzlaff et al. and in further view of Whayne et al. disclose the claimed invention. Tetzlaff et al. disclose a support device with a mating structure (122) configured to mate with the first clamp member, wherein the mating structure comprises a relatively narrow portion (the base of 122 immediately adjacent 121) and a relatively wide portion (the top or portion of 122 furthest from 121), see col. 6, lines 36-65 and figure 5.

Claims 7, 17 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phan (USPN 6,692,491) in view of Tetzlaff et al. (USPN 6,277,117 B1) and in further view of Whayne et al. (USPN 6,115,626) as applied to claims 6, 16 and 41 above, and further in view of by Bowe et al. (USPN 6,771,996).

Regarding claims 7, 17 and 42, Phan in view of Tetzlaff et al. and in further view of Whayne et al. disclose the claimed invention except for explicitly reciting the coagulation electrode length is greater than the stimulation electrode length. Bowe et al. disclose an ablation and mapping device and teach providing coagulation electrode length(s) that are greater that the mapping/stimulation electrode length(s) in order to provide mapping/stimulation and ablation/coagulation to cardiac tissue, see figures 1-16.

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Phan in view of Tetzlaff et al. and in further view of Whayne et al., as further taught by Bowe et al., to provide coagulation electrode length(s) that are greater that the mapping/stimulation electrode length(s) in order to provide mapping/stimulation and ablation/coagulation to cardiac tissue.

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phan (USPN 6,692,491) in view of Tetzlaff et al. (USPN 6,277,117 B1) and in further view of Whayne et al. (USPN 6,115,626) as applied to claims 6, 16 and 41 above, and further in view of by Maguire et al. (USPN 6,997,925).

Regarding claims 10 and 20, Phan in view of Tetzlaff et al. and in further view of Whayne et al. disclose the claimed invention except for explicitly reciting first and second coagulation element wires connected to the coagulation element. Maguire et al. disclose a device and method of delivering ablative/coagulating energy to cardiac tissue and teach the alternative/equivalence of delivering ablative/coagulating energy via resistive heating, rf current delivery and ultrasound that are "sufficient to ablate tissue when coupled to a suitable excitation source," see col. 17, line 56 through col. 18, line 11. Resistive heaters have a first and second wire connected to them and to the energy source. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Phan in view of Tetzlaff et al. and in further view of Whayne et al., as further taught by Maguire et al., to provide

alternative/equivalence of delivering ablative/coagulating energy via resistive heating instead of rf current delivery "sufficient to ablate tissue when coupled to a suitable excitation source" in order to ablate/coagulate cardiac tissue.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phan (USPN 6,692,491) in view of Tetzlaff et al. (USPN 6,277,117 B1) and in further view of Whayne et al. (USPN 6,115,626) as applied to claims 6, 16 and 41 above.

Regarding claim 11, Phan in view of Tetzlaff et al. and in further view of Whayne et al. disclose the claimed invention except for explicitly reciting the stimulation element is located distally of the coagulation element. However, the placement of the stimulation element proximally, along side of or distally with respect to the coagulation element is well known in the art. Where there is a limited universe of potential options, the selection of any particular option would have been obvious to one of ordinary skill in the art. In re Jones, 412 F.2d 241, 162 USPQ 224 (CCPA 1969). Therefore, at the time of the invention, it would have been an obvious matter of design choice to one of ordinary skill in the art to place the stimulation element distally with respect to the coagulation element.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.R. A.R.
August 20, 2006

John P. Leubecker
Primary Examiner